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EXAMINER
SAEED, USMAAN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 November 2007_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-13 and 16-24_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-13 and 16-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _15 October 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _11/16/2007_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Receipt of Applicant's Amendment, filed 11/16/2007 is acknowledged.

Claims 1-13, and 16-24 are pending in this office action.

Information Disclosure Statement

2.   Applicants' Information Disclosure Statement, filed on 11/16/2007 has been

received, entered and considered. See attached form PTO-1449.

Claim Rejections - 35 USC § 101

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-13, and 16-24 are rejected under 35 U.S.C. 101 as being directed to

non-statutory subject matter. The language of the claims raises a question as to

whether the claims are directed merely to an environment or machine which would

result in a practical application producing a concrete useful, and tangible result to form

the basis of statutory subject matter under 35 U.S.C. 101.

Claims 1-13, and 16-24 are rejected because the modules recited in these claims

are implemented as software routines. Therefore these claims are system of software

per se, failing to fall within a statutory category of invention.

Appropriate correction is required.

To expedite a complete examination of the instant application the claims rejected

under U.S.C. 101 (nonstatutory) above are further rejected as set forth below in

anticipation of application amending these claims to place them within the four

categories of invention.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1-13, 16-21, and 24 are rejected under 35 U.S.C 103(a) as being

unpatentable over **Simpson et al. (Simpson** hereinafter) (US Patent No. 6,549,894) in

view of **Cecily Anne Snyder (Snyder** hereinafter) (U.S. PG Pub No. 20020111953).

With respect to claim 1, **Simpson** teaches **a system for managing patent application data via the Internet, comprising:**

"**a matter module, the matter module operable to manage data relating to patent matters, the managed data comprising docketing data**" as (**Simpson** Col 5, Lines 5-27).

"**a tasks module, the tasks module operable to manage tasks related to each matter managed by the matter module, the tasks comprising docketing tasks**" as (**Simpson** Col 1, Lines 66-67 and Col 2, Lines 1-36).

"**a security module, the security module operable to restrict access to patent application task and matter data management to selected system users**" as (**Simpson** Col 5, Lines 28-48). These lines teach that only authorized users are allowed to access the docketing system and each user has security access levels.

"**a messaging module operable to provide messaging to users of the system, wherein the messaging comprises automated message to particular users, the message relating to matters and tasks associated with the particular users and stored in a manner searchable and retrievable by matter**" as (**Simpson** Col 5, Lines 5-67 and Abstract). Examiner interprets the due dates in different color as being used as an alert/message to particular users who are authorized.

Further, **Simpson** teaches that certain due dates are automatically calculated in each country (such as trademark registration renewal dates, for example). When an action is completed, a removal date is entered in the Removal Date column in the row associated with the action completed. As mentioned previously, the LegalStar logo in

the upper right of the screen is also color-coded. The star logo is either green, yellow or red, depending on the status of the SBD dates for that particular matter (**Simpson** Col 7, Lines 22-34 and Figure 5).

These lines and figure 5 shows alerting/messaging the users about the due dates which are automatically calculated and stored and also the star logo alerts/messages the users by changing the color.

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Figure 5A

Simpson teaches the elements of claim 1 as noted above but does not explicitly teaches **"the messaging comprises automated message to particular users"** and **"Internet access to applications."**

However, **Snyder** discloses **"the messaging comprises automated message to particular users"** as in response to events related to the cases which result in one or more deadlines, the present invention automatically generates messages notifying users of deadlines associated with the events. The docketing messages are then automatically communicated to appropriate recipients (**Snyder** Abstract).

"Internet access to applications" as (**Snyder** Figure 1). Figure 1 shows that internet access to patent application matters. Snyder also teaches that particular entities are associated with particular matters.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because **Snyder's** teaching would have allowed **Simpson** to provide an efficient and up to date docket management system by tracking all correspondence, communications, relevant dates and relevant events for patent applications and sending messages notifying users of deadlines associated with the events.

With respect to claim 2-4, **Simpson** teaches **"wherein managing data relating to patents matters comprises creating new patent matter data, retrieving patent matter data and editing patent matter data"** as (**Simpson** Col 7, Lines 1-12).

With respect to claim 5, **Simpson** teaches **"wherein managing tasks related to managed matters comprises automated creation of tasks"** as (**Simpson** Col 3, Lines 6-8).

With respect to claim 6, **Simpson** teaches **"wherein managing tasks related to managed matters comprises user creation of tasks"** as (**Simpson** Col 7, Lines 1-12).

With respect to claim 7-10, **Simpson** teaches **"wherein managing tasks related to managed matters comprises retrieving tasks for a particular matter, user organization and editing tasks"** as (**Simpson** Col 7, Lines 1-12).

With respect to claim 11, **Simpson** teaches **"wherein managing tasks related to managed matters comprises viewing a calendar of tasks"** as (Simpson Figures 5A-5C and Figure 7).

With respect to claims 12-13 **Simpson** teaches **"wherein the security module requires a user to log in before granting access to matter or task data, and wherein the security module further grants the logged in user access only to those matters and tasks to which the user has been granted access and, wherein users are granted access to matters and tasks by the creator of each matter or task"** as (**Simpson** Col 7, Lines 1-12 and Figure 2).

14-15. (Canceled).

With respect to claim 16, **Simpson** teaches **"wherein the messaging comprises a user sending messages to other users"** as (**Simpson** Col 3, Lines 4-17).

With respect to claim 17, **Simpson** does not explicitly teaches **"wherein the messaging module is further operable to send electronic mail (e-mail) to users, the e-mail comprising information relating to the user's role in managed tasks and matters."**

However, **Snyder** discloses **"wherein the messaging module is further operable to send electronic mail (e-mail) to users, the e-mail comprising information relating to the user's role in managed tasks and matters"** as (**Snyder** Paragraph 0065).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because **Snyder's** teaching would have allowed **Simpson** to provide an efficient and up to date docket management system by tracking all correspondence, communications, relevant dates and relevant events for patent applications and sending messages notifying users of deadlines associated with the events.

With respect to claim 18-20, **Simpson** does not explicitly teaches **"wherein the system comprises world wide web site, application server pages and java server pages."**

However, **Snyder** discloses **"wherein the system comprises world wide web site, application server pages and java server pages"** as (**Snyder** Figure 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because **Snyder's** teaching would have allowed **Simpson** to provide an efficient and up to date docket management system by tracking all correspondence, communications, relevant dates and relevant events for patent applications and sending messages notifying users of deadlines associated with the events.

With respect to claim 21, **Simpson** teaches **"wherein the system further comprises a database for managing patent application"** as (**Simpson** Abstract).

With respect to claim 24, **Simpson** teaches **"wherein multiple matters may be associated with each other, such that data relating to one of the multiple matters will be visible when viewing data relating to another of the multiple matters"** as (**Simpson** Figure 5A).

25-96. (Cancelled).

Claims 22-23 are rejected under 35 U.S.C 103(a) as being unpatentable over **Simpson et al.** (US Patent No. 6,549,894) in view of **Cecily Anne Snyder** (U.S. PG

Pub No. 20020111953) as applied to claims 1-13, 16-21, and 24 above, further in view

of **Lee et al.** (**Lee** hereinafter) (U.S. Patent No. 6,839,707).

With respect to claim 22 and 23, **Simpson and Snyder** do not explicitly teach

"wherein the system comprises multiple databases and is able to exchange data

between multiple databases and synchronizing data in databases by publishing

changes to one database to the other associated databases."

However, **Lee** discloses **"wherein the system comprises multiple databases**

and is able to exchange data between multiple databases" as (**Lee** Figure 2) and

"synchronizing data in databases by publishing changes to one database to the

other associated databases" as (**Lee** Abstract and Figure 18).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of the cited references because **Lee's**

teaching would have allowed **Simpson and Snyder** to provide management tools

configured to drive accountability and performance and to improve operational efficiency

by providing a fully integrated on-line web based communication tool.

Response to Arguments

4.   Applicant's arguments have been considered but are moot in view of the new

ground(s) of rejection.

See above rejections for response to the arguments.

Claims must be given the broadest reasonable interpretation during examination and limitations appearing in the specification but not recited in the claim are not read into the claim (See M.P.E.P. 2111 [R-I]).

Contact Information

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usmaan Saeed whose telephone number is (571)272-4046. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571)272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner
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US
March 5, 2007